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OFFICE OF PETITIONS

In re Patent No. 7,603,567
Issue Date: October 13, 2009
Application No. 10/779,633
Filed: February 18, 2004
Attorney Docket No. 04329.3243

: DECISION ON REQUEST
: FOR RECONSIDERATION OF
: PATENT TERM ADJUSTMENT
: AND
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION
:
:

This is a decision on the "APPLICATIONS FOR PATENT TERM ADJUSTMENT-POST GRANT", filed December 14, 2009, requesting that the patent term adjustment determination for the above-identified patent be changed from 812 days to 1160 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and in light of the court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).¹ The request is being treated under 37 CFR 1.705(d).

The petition is **GRANTED** to the extent indicated herein.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of one thousand eighty-two (**1082**) days.

It is undisputed that the period of examination delay, "A" delay", pursuant to 37 CFR 1.702(a)(1) is 900 days. However, as the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on February 18, 2007 and ends on June 29, 2008, the day before the RCE was filed, and the B delay considering the 229 days of overlap is 268 (not 269) days. See 35 U.S.C. 154(b)(1)(B)(i).

Additionally, while the Office initially determined a patent term adjustment which

¹Reconsidered in light of the Court of Appeals for the Federal Circuit's decision in Wyeth v. Kappos, 2009-1120 (Fed. Cir. 1-7-2010).

included 2 days of applicant delay, pursuant to 37 C.F.R. § 1.704(c)(10), a period of reduction totaling 86 days was entered for applicant filing papers after the mailing of the notice of allowance. Patentees argue that because the Examiner failed to acknowledge applicant's claim for priority during prosecution, a copy of the first page of the certified copy of the foreign priority document along with a copy of the postcard filed with the certified copy of the foreign priority document stamped by the U.S. Patent and Trademark Office to indicate receipt of the priority document, was re-filed on July 20, 2009. Accordingly, Patentee argues that the July 20, 2009 submission of the certified copy of the foreign priority document should not be deemed a failure to engage in reasonable efforts to conclude processing or examination of an application under 37 CFR § 1.704(c)(10) and disputes the reduction of 86 days of applicant delay.

The reduction of 86 days has been found to be incorrect. A review of the application file, as stated by Patentee, supports a conclusion that the certified copy of the foreign priority document had been previously filed. Thus there is no delay pursuant to 37 CFR 1.704(c)(10) and the 86 day reduction will be removed.

As such, the patent term adjustment is 1082 (900 "A delay days" + 497 "B delay days" - 229 days overlap - 2 Applicant delay days) days, not 1160 days.

The Office acknowledges the authorization to charge the \$200.00 fee set forth in 37 CFR 1.18(e) to deposit account no. 06-0916.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand eighty-two (1082) days**.

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT
UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,603,567 B2

DATED : October 13, 2009

INVENTOR(S) : Hirofumi Kanai

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (812) days

Delete the phrase "by 812 days" and insert – by 1082 days--